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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/657,687	09/08/2003	Salvatore Rea	2002L007A	1241

7590
Infineum USA L.P.
Law Department
1900 East Linden Avenue
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Linden, NJ 07036-0710

EXAMINER

RONESI, VICKEY M

ART UNIT	PAPER NUMBER
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1796

MAIL DATE	DELIVERY MODE
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05/07/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/657,687	Applicant(s) REA ET AL.	
	Examiner VICKEY RONESI	Art Unit 1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 January 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The outstanding 103 rejection over US 6,642,188 is withdrawn in light of applicant's statement of common ownership at the time of invention.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior office action.
3. No new grounds of rejection are set forth below. Thus, the following action is properly made final.

Claim Rejections - 35 USC § 103

4. Claims 1-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ogano et al (US 6,207,625, cited on IDS dated 12/24/2003) in view of Brehm (US 3,893,168) or Whitacre (US 2,833,717).

The rejection is adequately set forth in paragraph 2 of Office action mailed on 1/24/2008 and is incorporated here by reference.

5. Claims 1-9 and 11-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker et al (US 6,444,624) in view of Holubec (US 3,876,550) and further in view of Brehm (US 3,898,168) or Whitacre (US 2,833,717).

The rejection is adequately set forth in paragraph 2 of Office action mailed on 1/24/2008 and is incorporated here by reference.

Double Patenting

6. Claims 1-19 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-14 of U.S. Patent No. 6,642,188.

The rejection is adequately set forth in paragraph 2 of Office action mailed on 1/24/2008 and is incorporated here by reference.

7. The terminal disclaimer filed on 11/12/2007 was disapproved because the attorney, Jacques B. Miles, is not of record.

Response to Arguments

8. Applicant's arguments filed 1/24/2008 have been fully considered but they are not persuasive. Specifically, applicant argues (A) that neither Ogano et al nor Walker et al discloses a lubricating oil composition for use in a four stroke marine engine; (B) that the examiner is improperly picking and choosing based on improper hindsight; and (C) that none of the cited references suggests a two component rust inhibitor system.

With respect to argument (A), regarding the composition claims, the phrase "for use in a four stroke marine engine" is intended use and is not considered to be a claim limitation. Case law holds that a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). With respect to the method of operating and

Art Unit: 1796

lubricating a four cycle marine engine, it would have been obvious to one of ordinary skill in the art to utilize the lubricant compositions taught by Ogano et al and Walker et al in a four cycle marine engine because both of them teach using the lubricant in diesel engines (diesel engines are either two- or four-cycle) which are treated with an anti-rust agent, i.e., an agent that renders the lubricant suitable for use in a marine environment. The applicant also states that the examiner has applied an "obvious to try standard" which, according to applicant, "is not the law" (p. 10 of the Amendment). The examiner disagrees that such a standard has been applied. But even if it were, it is incorrect to say that it "is not the law". Applicant is directed to the Supreme Court's decision in *KSR v. Teleflex*, 550 U.S. ___, 82 USPQ2d 1385 (2007). In that decision, "obvious to try" was specifically cited as an exemplary rationale (cf. rationale E as cited in MPEP 2141) that may support a conclusion of obviousness. Clearly, it is the law contrary to applicant's opinion. The Court went on to say that the key to making a proper obviousness rejection is to provide "some clearly articulated reasoning." It is clear from the record that the examiner has indeed supplied such a clearly articulated reasoning to support the obviousness rejection. Hence the rejection is maintained as being sound and proper.

With respect to argument (B), there is no improper picking and choosing because the examiner has only taught in specific known anti-rust agents for lubricants into a lubricant composition already disclosed to contain anti-rust agents. Case law holds that the selection of a known material based on its suitability for its intended use supports *prima facie* obviousness. *Sinclair & Carroll Co vs. Interchemical Corp.*, 325 US 327, 65 USPQ 297 (1945). Regarding improper hindsight, Case law holds that it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes

Art Unit: 1796

into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

With respect to argument (C), Case law holds that it is *prima facie* obvious to combine two ingredients, each of which is targeted by the prior art to be useful for the same purpose. *In re Lindner* 457 F,2d 506,509, 173 USPQ 356, 359 (CCPA 1972). Therefore, given that the prior art references teach the presently claimed rust inhibitors, it would have been obvious to one of ordinary skill in the art utilize a combination of two or more, absent a showing of unexpected or surprising results with respect to the combination. The examples of the instant specification provide little to no probative value, given that only combinations of 4 mole ethoxylate of nonyl phenol, dodecyl(tetrapropyl) succinic acid, and glycerol oleates are exemplified and there are no comparative examples which use only one rust inhibitor.

Conclusion

9. **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

Art Unit: 1796

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vickey Ronesi whose telephone number is (571) 272-2701. The examiner can normally be reached on Monday - Friday, 8:30 a.m. - 5:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (571) 272-1119. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

5/1/2008

Vickey Ronesi

/V. R./

Examiner, Art Unit 1796

/VASUDEVAN S JAGANNATHAN/

Supervisory Patent Examiner, Art Unit 1796